

Remarks

Claims 34-110 and 112-171 were pending, of which claims 34-103 and 117-171 are withdrawn from current consideration. By this reply, claim 104 is currently amended, claims 34-103, 115, and 117-171 are canceled without prejudice or disclaimer, and no new claims are presented. No new matter is introduced.

Claim 104 is currently amended to incorporate the limitations of claim 115, i.e., to specify that the oligonucleotide 10-50 nucleotides long includes a sequence chosen from GGGGG, GAGGG, GGGAG, GTGGG, and GGGTG, wherein the oligonucleotide does not comprise a CG dinucleotide. Additional support for this amendment can be found, for example, on page 12 of the previously submitted substitute specification (or page 10 of the published PCT application).

Applicants gratefully acknowledge that the Examiner has withdrawn the prior objection to the specification, the prior rejection of claims 104-116 under 35 U.S.C. § 112, first paragraph, and the prior rejection of claims 104, 105, 107-110, and 114 under 35 U.S.C. 102(b).

Drawings

The Examiner indicated that the drawings received on 9/24/03 were not acceptable and that new corrected drawings would be required as part of this reply. Applicants' representative wishes to thank the Examiner for the opportunity to discuss this point in a telephone interview conducted on March 3, 2004. During the interview, the Examiner acknowledged that, upon further review, the drawings received on 9/24/03 are in fact acceptable and no new corrected drawings are required as part of this reply. Accordingly, no corrected drawings are submitted as part of this reply.

Claim Rejections Under 35 U.S.C. § 102(e)

The Examiner indicated that claims 104-110 and 112-115 are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Zupi (US Pat. 6,080,727). For reasons stated below, Applicants respectfully disagree and request the Examiner to reconsider and withdraw the rejection of claims 104-110 and 112-115 under 35 U.S.C. § 102(e).

As a preliminary matter, Applicants respectfully submit that claim 115, prior to its cancellation and incorporation of its limitations into claim 104 by this amendment, was not anticipated by the cited reference. More specifically, while the Examiner alleged that the nucleotide sequences disclosed as SEQ ID NOs 10 and 17 used in the method taught by Zupi met the sequence requirement of claim 104 (prior to current amendment), the limitations of instant claim 115 were not taught by Zupi. In particular, the limitations of claim 115 specify certain sequences, namely GGGGG, GAGGG, GGGAG, GTGGG, and GGGTG. None of these sequences is present in SEQ ID NOs 10 and 17 used in the method taught by Zupi. Furthermore, while the sequence GAGGG is present in SEQ ID NO:1 and the sequence GGGAG is present in SEQ ID NO:9 of Zupi, both SEQ ID NO:1 and SEQ ID NO:9 of Zupi also contain a CG dinucleotide. Instant claim 104 specifies, however, that the oligonucleotide does not comprise a CG dinucleotide. Therefore, neither original claim 115 nor claim 104 as currently amended is anticipated by any of SEQ ID NOs 1, 9, 10, or 17 of Zupi. In addition, while SEQ ID NO:4 of Zupi includes the sequence GGGTG and does not include a CG dinucleotide, Zupi specifically teaches that, in Zupi's hands, SEQ ID NO:4 is not functional in the method claimed by Zupi. None of the other sequences disclosed in Zupi include GGGGG, GAGGG, GGGAG, GTGGG, or GGGTG. Therefore, it is submitted that original claim 115 was not anticipated by Zupi.

In view of the foregoing, it is submitted that claim 104 as currently amended to incorporate the limitations of claim 115 also is not anticipated by Zupi. Specifically, none of the sequences taught by Zupi which exclude a CG dinucleotide and are there disclosed to be useful in the method of Zupi include a sequence chosen from GGGGG, GAGGG, GGGAG, GTGGG, and GGGTG. Therefore it is submitted that claim 104 as currently amended is not anticipated by

Zupi. Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw the rejection of claims 104-110 and 112-114 under 35 U.S.C. § 102(e).

On page 5 of the Office Communication, the Examiner requested clarification with respect to a statement in the first paragraph under the heading Claim Rejections – 35 U.S.C. § 102(e) on page 8 of the previous amendment. Suffice it to say the Applicants' statement is intentionally worded to characterize what Zupi, not the instant application, teaches. Specifically, as should be clear from the context, Applicants were intending to distinguish over the teachings of Zupi because the latter "emphasizes that the G quartet structure alone is not sufficient to inhibit melanoma tumor growth because control oligonucleotides having scrambled sequence (relative to c-myc mRNA) and a G quartet were not effective, according to Zupi, to inhibit human melanoma growth" [emphasis added]. The Examiner asserts that this teaching of Zupi is in apparent contradiction to the teachings of the instant application, and Applicants in reply submit it was not cited by the Applicants as an admission of its veracity. Applicants wish to thank the Examiner for the opportunity to make this clarification.

Claim Rejections Under 35 U.S.C. § 103(a)

The Examiner indicated that claims 104 and 116 remain rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Zupi (US Pat. 6,080,727) taken with Kuby (Immunology, 2nd edition, W.H. Freeman Company, 1994). For reasons stated below, Applicants respectfully disagree and request the Examiner to reconsider and withdraw the rejection of claims 104 and 116 under 35 U.S.C. § 103(a).

In view of the current amendment of claim 104, it is submitted that the rejection of both claim 104 and 116 is overcome because claim 104 as currently amended incorporates the limitations of claim 115, which was not rejected under 35 U.S.C. § 103(a). Claim 116 depends from claim 104. Accordingly, the basis for the claim rejections under 35 U.S.C. § 103(a) is removed. Applicants therefore respectfully request the Examiner to reconsider and withdraw the rejection of claims 104 and 116 under 35 U.S.C. § 103(a).

Summary

It is believed that the claims are in condition for allowance. A prompt and favorable action is earnestly solicited.

Respectfully submitted,
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